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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,900

06/14/2005

Scott Thomas Milner

2003B133A

6056

23455 7590 07/31/2007
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EXAMINER

RABAGO, ROBERTO

ART UNIT

PAPER NUMBER

1713

MAIL DATE

DELIVERY MODE

07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,900

Applicant(s)

MILNER ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-18,20-51,53 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-18,20-51,53 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/27/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Prosecution in this application is reopened in view of new grounds of rejection as set forth below. The amendment filed 7/6/2007 is entered.

Information Disclosure Statement

2. The information disclosure statement filed 2/27/2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the Matyjazewski reference has not been considered because no copy has been provided. The document provided by applicants consists of nothing but the title and publication page.

Claim Objections

3. Claim 21 is objected to because in lines 4-5, the phrase "independently selected from the group" has been repeated.

Claim Rejections - 35 USC § 103

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halasa (US 4,248,988).

The reference discloses in Example XIV(d), by reagent substitution into Example III, a method of polymerizing butadiene in the presence of a nickel complex, triisobutyl aluminum, toluene and approximately 10% 2,3-difluorobutane, with molecular weights between 10,000 and 100,000 (see also col. 2, lines 18-20). Missing is the use of a polymerization temperature of less than 0°C. However, one of ordinary skill in the art would be motivated to use the claimed temperatures because the reference has suggested such use at col. 5, lines 38-39.

Double Patenting

4. Claims 1-7, 9-18, 20-51, 53 and 59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-61 of copending Application No. 10/539,013 for the reasons set forth in item 11 of the Office action mailed 6/30/2006.

Applicant's arguments filed 7/6/2007 have been fully considered but they are not persuasive. Applicants argue that the copending application, filed on the same day and having the same oldest priority date, can be considered to include an improvement over the instant claims, and therefore the instant application should be allowed to issue without a terminal disclaimer. However, in view of the fact that this rejection is not the sole remaining issue, and further in view of the still changeable nature of the claims in both applications, the provisional ODP rejection is maintained.

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5. Claims 1-7, 9-18, 20-51, 53 and 59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-106 of Patent 7,232,872 because, in spite of somewhat different organization and grouping of limitations, essentially the same process of polymerization is being claimed in each application, except for the recitation of reactor temperature and pressure. The instant claims require a temperature of less than 0°C, pressure up to 14,000 kPa, while the copending claims are silent on reaction temperature and pressure. However, use of the claimed temperature would be obvious because the admitted prior art described in the copending patent at col. 1-3 indicates that use of such temperatures are entirely conventional in the art, furthermore supported by all of the copending working examples. Use of the required pressure would be obvious because applicants have claimed the vast majority of conventional polymerization reaction pressures.

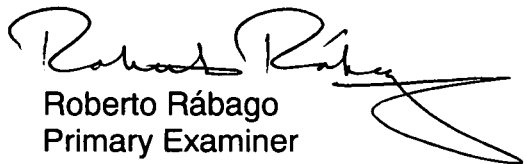
Applicant's arguments filed 7/6/2007 have been fully considered but they are not persuasive. Applicants are apparently arguing that the rejection should be withdrawn because a terminal disclaimer has already been filed in the '984 application over the instant application. The disclaimer in the patented case appears to have been filed for the purpose of advancing prosecution, yet this application contains additional claimed features (i.e., at least the reaction pressure and temperature). Therefore, because the instant claims include additional expressly recited features, the rejection is maintained.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Roberto Rábago
Primary Examiner
Art Unit 1713

RR
July 30, 2007